

Application No. 10/609,120
Attorney Docket No. 11187-00016
(Endow-3)
Reply to Office Action of April 24, 2006

REMARKS

In the Office Action under reply, claims 7-9, 12-16, and 26-32 are pending. The Examiner has rejected the claims as follows:

1. Under 35 U.S.C. §112, first paragraph, as lacking enabling disclosure in the specification (claims 7-9, 12-14, 16, and 26-28);
2. Under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement (claims 7-9, 12-14, 16, and 26-28);
3. Under 35 U.S.C. §102(b) as anticipated by Shao et al. (claims 27 and 28);
4. Under 35 U.S.C. §102(b) as anticipated by Lei et al. (claims 27 and 28);
5. Under 35 U.S.C. §102(b) as anticipated by Zhou et al. (claims 27 and 28);
6. Under 35 U.S.C. §102(b) as anticipated by Tseng et al. (claims 27 and 28);
7. Under 35 U.S.C. §102(b) as anticipated by Diedrich et al. (claims 27 and 28);
8. Under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 3,907,830 to Feuer et al. (claims 27 and 28); and
9. Under 35 U.S.C. §103(a) as obvious over U.S. Patent Nos. 4,166,862 and 3,907,830 to Feuer.

In the current amendment, claims 7, 8, 26, and 27 have been amended. Thus, claims 7-9, 12-16, and 26-32 remain pending in the application. The Examiner's rejections and objections are addressed in part by the above-amendments and are otherwise traversed for the reasons presented below.

THE AMENDMENTS TO THE CLAIMS

Claims 7, 8, 26, and 27 have been amended to remove the alkoxy, cycloalkoxy, haloalkoxy, cyclohaloalkoxy, and alkynyloxy from the list of permitted R₁ substituents and to remove "sugar" from the permitted R₃ substituents.

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Claim 26 has been additionally amended to remove hydrogen, haloalkyl, and cycloalkylcarbonyl, substituents from the permitted R_1 moieties.

Claim 27 has been additionally amended to remove hydrogen, carboxy, halo, amino, alkyl, alkenyl, and alkoxy substituents from the list of permitted R_5 moieties.

No new matter has been added by virtue of these amendments.

THE REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner has rejected claims 7-9, 12-14, 16, and 26-28 as lacking enabling disclosure in the specification and failing to comply with the written description requirement. The Examiner has based these rejection on the view that the claims are not enabled and the specification does not reasonably convey that the inventor had position of those compounds wherein the R_1 moiety is an "oxy" derivative, such as alkoxy, or those compounds wherein R_5 is "sugar." As such R_1 and R_5 substituents are no longer permitted, Applicants submit that both rejections under 35 U.S.C. §112, first paragraph, as it pertains to claims 7, 8, 26, and 27 and all claims dependent thereupon are now moot.

THE REJECTION UNDER 35 U.S.C. §102(b) OVER SHAO ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of Shao et al. asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

Shao et al. discloses isoflavone derivatives wherein the R_1 substituent is H, alkyl, acyl, or pyridine-3-yl-carboxy. As none of these groups are permitted in the R_1 position of independent claim 27 as amended herein, the compound of Shao et al. cannot serve as the basis for a rejection under 35 U.S.C. §102(b). Reconsideration and withdrawal of the rejection over Zheng et al. is accordingly requested.

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THE REJECTION UNDER 35 U.S.C. §102(B) OVER LEI ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of Lei et al. asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

The Examiner has cited the compounds in Lei et al. for their disclosure of compounds wherein R_1 is hydrogen and R_5 is alkyl. As R_5 is no longer permitted to be alkyl in claims 27 or 28, the Lei et al. compounds do not anticipate the rejected claims. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

THE REJECTION UNDER 35 U.S.C. §102(B) OVER ZHOU ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of Zhou et al. asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

The compounds in Zhou et al. possess R_5 methoxy groups. As R_5 is no longer permitted to be alkoxy in claims 27 or 28, the Zhou et al. compounds do not anticipate the rejected claims. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

THE REJECTION UNDER 35 U.S.C. §102(B) OVER TSENG ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of Tseng et al. asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

The compounds in Tseng et al. possess R_5 groups selected from Me, CH:CHCH₂, 3,4,5-(MeO)₃C₆H₂C(O)-. As R_5 is no longer permitted to be any of these substituents in claims 27 or

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28, the Tseng et al. compounds do not anticipate the rejected claims. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

THE REJECTION UNDER 35 U.S.C. §102(B) OVER DIEDRICH ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of Diedrich et al. asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

The compounds in Diedrich et al. possess R_5 groups selected from nitro and methoxy. As R_5 is not permitted to be either of these substituents in claims 27 or 28, the Diedrich et al. compounds do not anticipate the rejected claims. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

THE REJECTION UNDER 35 U.S.C. §102(B) OVER FEUER ET AL.

The Examiner has rejected claims 27 and 28 over the disclosure of U.S. Patent No. 3,907,830 Feuer et al. (the '830 patent) asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

The compounds in the '830 patent possess R_5 groups selected from various optionally substituted saturated or unsaturated alkyl groups. As R_5 is no longer permitted to be optionally substituted saturated or unsaturated alkyl in claims 27 or 28, the '830 patent compounds do not anticipate the rejected claims. Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

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**THE REJECTION UNDER 35 U.S.C. §103(A) OVER U.S. PATENT NOS. 4,166,862 AND 3,907,830
TO FEUER**

The Examiner has rejected claims 26 and 27 over the disclosure of U.S. Patent Nos. 4,166,862 to Feuer et al. (the '862 patent) and the '830 patent asserting that the compounds depicted therein anticipate the presently claimed invention. Applicants respectfully disagree.

With respect to claim 26, the compounds in the '830 patent possesses R₁ groups selected from various optionally substituted saturated or unsaturated alkyl groups. The '862 patent adds hydrogen and acyl to the list of suitable R₁ substituents. In contrast, the R₁ substituent in claim 26 is selected from the following:

carboxy, halo, amino, branched or straight chain (C₃-C₆)cycloalkoxyalkyl, (C₁-C₆)alkoxy(C₃-C₆)cycloalkyl, substituted or unsubstituted phenyl, phenyl(C₁-C₆)alkyl, and heterocyclylcarbonyl, wherein substituents are from one to four and are selected from the group consisting of halo, aminocarbonyl, aminothiocarbonyl, carboxy, formyl, hydroxy, amino, carbamoyl, (C₁-C₃)alkyl, (C₁-C₃)haloalkyl, (C₁-C₃)alkoxy, (C₁-C₃)haloalkoxy, (C₁-C₃)alkylamino, di(C₁-C₃)alkylamino, (C₁-C₂)alkoxy(C₁-C₂)alkyl, (C₁-C₂)alkylamino(C₁-C₂)alkyl, di(C₁-C₂)alkylamino(C₁-C₂)alkyl, (C₁-C₃)alkylcarbonyl, (C₁-C₃)alkoxycarbonyl, (C₁-C₃)alkylaminocarbonyl, and di(C₁-C₃)alkylaminocarbonyl;

As the lists of possible R₁ substituents do not overlap in any way, neither the '830 nor the '862 patents disclose all the elements of the current claims.

Similarly, looking at claim 27, the compounds in the '830 and the '862 patents possess R₅ groups selected from hydrogen, alkoxy, nitro, halogen, sulpho, or hydroxy. In contrast the R₅ substituent in claim 27 is selected from the group consisting of:

branched or straight chain (C₁-C₆)haloalkyl, (C₃-C₆)alkadienyl, (C₃-C₆)cycloalkoxy, (C₁-C₆)haloalkoxy, (C₃-C₆)cyclohaloalkoxy, (C₂-C₆)alkynyloxy, (C₁-C₆)alkoxy(C₁-C₆)alkyl, (C₃-C₆)cycloalkoxyalkyl, (C₁-C₆)alkoxy(C₃-C₆)cycloalkyl, (C₁-C₆)alkylcarbonyl, (C₃-C₆)cycloalkylcarbonyl, (C₁-C₆)alkoxycarbonyl, (C₄-C₆)alkoxycarbonylalkyl, (C₁-C₆)hydroxyalkyl, substituted or unsubstituted phenyl, phenyl(C₁-C₆)alkyl, heterocyclyl, heterocyclyloxy, heterocyclylcarbonyl, wherein substituents are from one to four and are selected from the group consisting of halo, aminocarbonyl, aminothiocarbonyl, carboxy, formyl, hydroxy, amino, carbamoyl, (C₁-C₃)alkyl, (C₁-C₃)haloalkyl, (C₁-C₃)alkoxy, (C₁-C₃)haloalkoxy, (C₁-C₃)alkylamino, di(C₁-C₃)alkylamino, (C₁-

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C₂alkoxy(C₁-C₂)alkyl, (C₁-C₂)alkylamino(C₁-C₂)alkyl, di(C₁-C₂)alkylamino(C₁-C₂)alkyl, (C₁-C₃)alkylcarbonyl, (C₁-C₃)alkoxycarbonyl, (C₁-C₃)alkylaminocarbonyl, and di (C₁-C₃)alkylaminocarbonyl

As the lists of possible R₅ substituents do not overlap in any way, neither the '830 nor the '862 patents disclose all the elements of the current claims.

Furthermore, neither the '830 nor the '862 provide any teaching or suggestion that the relatively limited groups disclosed therein in the R₁ and R₅ positions could be modified to encompass the moieties recited in Claims 26 and 27. The combination of references fails to provide a proper basis for *prima facie* obviousness under 35 U.S.C. §103(a) and the rejection is in error.

Reconsideration and withdrawal of the rejection are in order and are respectfully requested.

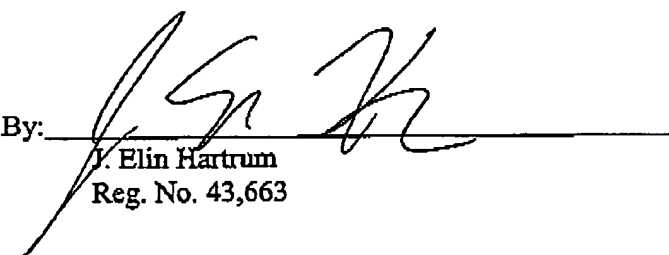
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CONCLUSION

For the foregoing reasons, Applicant submits that the claims are in condition for allowance. A Notice of Allowance is requested, and a prompt mailing thereof would be much appreciated.

Should the Examiner have any questions, he is invited to contact the undersigned attorney at (650) 384-8755.

Respectfully submitted,

Date: 7/18/06 By: 
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